REMARKS

Claims 11 and 24 are canceled herein. Claims 1-6, 8-10, 12-19, 21, 22, 25-37, 39 and 41-44 now remain pending in the application.

Objection to the Drawings

The Office Action objected to the drawings under 37 CFR 1.83(a) as allegedly lacking features recited in claims 6, 8, 10, 11, 19, 21 and 24.

Claim 11 and 24 are canceled herein, making the rejection of claims 11 and 24 now moot.

Claims 6, 8, 10, 11, 19, 21 and 24 are dependent claims that further restrict their respective independent claims, i.e., simply define the type of motion sensor. In particular, claims 6, 8, 10, 11, 19, 21 and 24 respectively further limit the claimed "motion sensor" comprises "a transceiver that complies with a BLUETOOTH® standard", "a global positioning system (GPS) receiver" and a "a voice recognition unit". The claimed motion sensor is clearly disclosed in Fig. 1 as, e.g., item 120, with dependent claims 6, 8, 10, 19 and 21 simply defining the type of motion sensor. Moreover, Applicants Fig. 1 discloses a BLUETOOTH® transceiver as item 140, a GPS receiver as item 120, a voice recognition unit as item 115.

The Applicants respectfully request the objection under 37 CFR 1.83(a) to the drawings as allegedly lacking features recited in claims 6, 8, 10, 19 and 21 be withdrawn.

35 USC 112 First Paragraph Rejection of Claims 6, 8, 10, 11, 19, 21 and 24

The Office Action rejected claims 6, 8, 10, 11, 19, 21 and 24 under 35 USC 112, first paragraph. In particular, the Office Action alleges claimed features are not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Applicants respectfully disagree.

Claim 11 and 24 are canceled herein, making the rejection of claims 11 and 24 now moot.

Applicants disclose use of a BLUETOOTH® transceiver to detect motion at, e.g., page 11, lines 7-9 that detail use of a BLUETOOTH® transceiver to detect motion through broken communications.

Applicants disclose use of a GPS receiver to detect motion at, e.g., page 11, lines 9-11 that detail use of a GPS receiver to detect changes in coordinates over some period of time.

The Examiner alleges in the Response to the Arguments section of the Office Action that the specification "is very clear that proximity detectors comprises motion sensors (#120), accelerometers, voice recognition units (#115), BLUETOOTH transceivers (#140), but the specification does not support the motion sensor (#120) comprises accelerometers, voice recognition units, or BLUETOOTH transceivers." (See Office Action, page 9). The Applicants respectfully disagree.

The Examiner is directed toward Applicants' specification at page 5, lines 16-18 that disclose "Typical examples of proximity detectors which may be used with the invention include motion sensors (e.g., 120) such as e.g., accelerometers, voice recognition units (e.g., 115), BLUETOOTH® transceivers (e.g., 140), etc." Thus, Applicants' specification DOES disclose motion sensors comprise e.g., accelerometers, voice recognition units, BLUETOOTH® transceivers.

Moreover, the Examiner argues in the Response to Arguments section of the Office Action that the specification fails to even mention a GPS receiver, with Applicants' specification stating "it should be pointed out that global positioning system (GPS) technology may be employed by motion sensor 120." However, the Examiner is citing Applicants' page 5. The Examiner is directed toward Applicants' page 11, lines 9-11 that detail use of a GPS receiver to detect changes in coordinates over some period of time.

The Applicants respectfully request the rejection of claims 6, 8, 10, 19 and 21 under 35 USC 112, first paragraph, be withdrawn.

35 USC 112 Second Paragraph Rejection of Claims 6, 18, 19 and 37

The Office Action AGAIN rejected claims 6, 18, 19 and 37 under 37 CFR, second paragraph for claiming a "BLUETOOTH™ device" and a "BLUETOOTH™ transceiver".

Applicants erroneously referred to BLUETOOTH® as being a trademark while it is in fact a registered mark. The Applicant's' specification and claims are amended herein to correctly refer to BLUETOOTH® as a registered mark.

Moreover, claims 6, 18, 19 and 37 are amended herein from a "BLUETOOTH™ device" and a "BLUETOOTH™ transceiver" to "device that complies with a BLUETOOTH® standard" and a "transceiver that complies with a BLUETOOTH® standard" as suggested by the Examiner.

The Examiner kindly granted Applicants an informal interview on February 8, 2006 to discuss Applicants use of a registered mark within the claims. However, the Examiner maintained that a registered mark is a trademark, and that a registered mark cannot be used to properly identify or describe any particular material or product, but is a source of goods, and not the goods themselves. The Applicants were directed to see *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

The Examiner pointed to the use of BLUETOOTH® as covering "telecommunication areas, control mechanisms for machines, signaling, apparatus and instruments for data communication, and telecommunication, radios, transmitters, receivers, and even bread toasters". However, ALL of the Examiner's examples are **APPLICATIONS** of BLUETOOTH® **NOT** a source of BLUETOOTH®. A trademark cannot generally cover generic segments of a market, as a trademark represents a particular manufacturer's good, i.e. the purpose of obtaining a trademark to uniquely identify a good within a market. In contrast to a trademark, ANY manufacturer that complies with the BLUETOOTH® engineering standard can mark their good as being BLUETOOTH® compliant. The Examiner has still **NOT** addressed the fact that contrary to the use of the **Trademark** in *Ex parte Simpson*, BLUETOOTH® is an ENGINEERING piconet

STANDARD that **DOES NOT** represent a source of goods. Thus, claims 6, 19 and 37 recite a transceiver that complies with the BLUETOOTH™ ENGINEERING STANDARD for a piconet **NOT** a source of goods. If the Examiner continues to allege that BLUETOOTH® indicates a source of goods, the Examiner is respectfully requested to provide SUPPORT for **WHICH PARTICULAR** source of goods BLUETOOTH® is allegedly from.

Claims 6, 18, 19 and 37 are in conformance with 37 CFR 112, second paragraph. The Applicants respectfully request the rejection of claims 6, 18, 19 and 37 under 37 CFR 112, second paragraph be withdrawn.

Claims 1-5, 11-15, 18, 24-32, 36 and 41-44 over Merriam in view of Knuth

In the Office Action, claims 1-5, 11-15, 18, 24-32, 36 and 41-44 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,408,187 to Merriam ("Merriam") in view of U.S. Patent No. 5,406,618 to Knuth ("Knuth"). The Applicants respectfully traverse the rejection.

Claims 11 and 24 are canceled herein, making the rejection of claims 11 and 24 now moot.

Claims 1-5, 12-15, 18, 25-32, 36 and 41-44 recite a method and apparatus that notifies a user of a message upon sensing a portable wireless device has been moved.

The Examiner alleges that Applicants claims **fail** to recite notifying a user of a message upon sensing a portable wireless device has moved, and will not be read into the claims (See Office Action, page 11). The Applicants respectfully disagree.

Claims 1-6, 8-10, 12-19, 21, 22 and 25-35 recite a controller responsive to receipt of a signal indicating that a portable wireless device has been moved for activating a user notification unit to notify a user that a message arrived while the user was presumed not in a vicinity of said portable wireless device. Thus, claims 1-6, 8-19, 21, 22 and 24-35 recite an apparatus that notifies a user of a message upon sensing a portable wireless device has been moved.

Claims 36, 37, 39 and 41-44 recite notifying a user that a message had occurred while the user was not in a vicinity of a portable wireless device

upon detecting when the portable wireless device has been moved from a stationary position. Claims 36, 37, 39 and 41-44 recite a method that notifies a user of a message upon sensing a portable wireless device has been moved.

Claims 1-5, 12-15, 18, 25-32, 36 and 41-44 **DO** recite a method and apparatus that notifies a user of a message upon sensing a portable wireless device has been moved. Thus, the Examiner **ACKNOWLEDGES** that the Examiner has **FAILED** to consider **ALL** of the claimed features, and as such the rejection of clams 1-5, 12-15, 18, 25-32, 36 and 41-44 should be **WITHDRAWN**.

As previously discussed, Merriam appears to disclose a portable communication device that determines the proximity of a user to the portable communication device (col. 2, lines 4-7). In the likelihood that a user is within relatively close proximity to the portable communication device, a vibration or visual alert is activated instead of a audio alert (Merriam, col. 1, lines 59-65).

The Office Action acknowledges that Merriam fails to disclose a controller responsive to receipt of a signal for activating a user notification unit to notify a user that a message arrived while the user was presumed not in a vicinity of a portable wireless device (See Office Action dated March 29, 2004, page 4).

The Office Action relies on Knuth to allegedly make up for the deficiencies in Merriam to arrive at the claimed invention. The Applicants respectfully disagree.

Knuth appears to disclose a proximity sensor that determines the presence of a user in a vicinity of a telephone answering device (col. 5, lines 1-3). In response to the user being within the vicinity of the telephone answering device, a notice is given to the user that messages await (Knuth, col. 33-38).

Knuth's notification of messages awaiting recovery in a telephone answering device is in response to a proximity sensor that determines the presence of a user in a vicinity of the telephone answering device, the telephone answering device being a **stationary wired device**. Thus, Knuth producing a notification of a message awaiting recovery is in response to proximity sensor detecting motion within an environment of a **stationary** telephone answering device is **NOT** a method and apparatus notifying a user of a message upon

sensing a portable wireless device **has been moved**, as recited by claims 1-5, 12-15, 18, 25-32, 36 and 41-44.

Moreover, even if the theoretical combination of Merriam and Knuth were obvious (which it is not), the result would be a mobile telephone modified to producing a notification of a message awaiting recovery in response to proximity sensor detecting motion within an environment of the mobile telephone **when it remains stationary**. Neither Merriam nor Knuth disclose, teach or suggest a method and apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**, as recited by claims 1-5, 12-15, 18, 25-32, 36 and 41-44.

For these and other reasons, claims 1-5, 12-15, 18, 25-32, 36 and 41-44 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 6, 8-10, 19, 21-23, 37, 39 and 40 over Merriam in view of Knuth and Dorenbosch

In the Office Action, claims 6, 8-10, 19, 21-23, 37, 39 and 40 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Merriam in view of Knuth, and further in view of U.S. Patent No. 6,505,049 to Dorenbosch ("Dorenbosch"). The Applicants respectfully traverse the rejection.

Claims 23 and 40 are canceled herein, making the rejection of claims 23 and 40 now moot.

Claims 6, 8-10, 19, 21, 22, 37 and 39 are dependent on claims 1, 18 and 36 respectively, and are allowable for at least the same reasons as claims 1, 18 and 36.

Claims 6, 8-10, 19, 21, 22, 37 and 39 recite a method and apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**.

As discussed above, neither Merriam nor Knuth, either alone or in combination, disclose, teach or suggest a method and apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**, as recited by claims 6, 8-10, 19, 21, 22, 37 and 39.

The Office Action relies on Dorenbosch to allegedly make up for the deficiencies in Merriam in view of Knuth to arrive at the claimed invention. The Applicants respectfully disagree.

Dorenbosch appears to disclose a communication network that stores location information for the communication network (Abstract). A portable device determines whether the portable device is in motion (Dorenbosch, Abstract). The portable device, lacking on-board location-determination capability, determines its location from a network (Dorenbosch, col. 4, lines 48-65). A location based application, conventionally requiring a user to input a location, uses the location from the network (col. 1, lines 23-34). The determination of motion is used to suppress attempts to obtain location information from the network (Dorenbosch, col. 4, lines 48-65).

Dorenbosch discloses a location based application that uses location information obtained from a network. Motion of a portable device is used to stop attempts to obtain location information from the network. Thus, Dorenbosch's detection of motion for a portable device **suppresses actions** within the portable device, contrary to Applicant's method and apparatus that **take action** in response to detecting that a portable wireless device has been moved, i.e., a method and apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**, as recited by claims 6, 8-10, 19, 21, 22, 37 and 39.

Moreover, even if the theoretical combination of Merriam, Knuth and Dorenbosch were obvious (which it is not), the result would be a mobile telephone modified to producing a notification of a message awaiting recovery in response to proximity sensor detecting motion within an environment of the mobile telephone **when it remains stationary**. The notification of a message awaiting recovery by the mobile telephone would be suppressed until the mobile telephone is not in motion. Neither Merriam, Knuth nor Dorenbosch, either alone or in combination, disclose, teach or suggest a method and apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**, as recited by claims 6, 8-10, 19, 21, 22, 37 and 39.

Accordingly, for at least all the above reasons, claims 6, 8-10, 19, 21, 22, 37 and 39 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 16 and 33 over Merriam in view of Knuth and Himmel

Claims 16 and 33 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Merriam in view of Knuth, and further in view of U.S. Patent No. 6,622,015 to Himmel et al. ("Himmel"). The Applicants respectfully traverse the rejection.

Claims 16 and 33 are dependent on claims 1 and 18 respectively, and are allowable for at least the same reasons as claims 1 and 18.

Claims 16 and 33 recite an apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**.

As discussed above, neither Merriam nor Knuth, either alone or in combination, disclose, teach or suggest an apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**, as recited by claims 16 and 33.

The Office Action relies on Himmel to allegedly make up for the deficiencies in Merriam in view of Knuth to arrive at the claimed invention. The Applicants respectfully disagree.

Himmel appears to disclose a method and apparatus for using electronic documents within a smart phone (Abstract). A merchant, legal organization, or other entity provides an electronic document to a subscriber as proof of registration for a service or of legal entitlement (Himmel, Abstract). An appointment or calendar event can be sent as an e-document (Himmel, col. 8, lines 7-30).

The Office Action relies on Himmel to disclose an appointment reminder being sent to a smart phone. However, Himmel fails to disclose that the appointment reminder is given notice to a user upon sensing a portable wireless device **has been moved**, as recited by claims 16 and 33.

Neither Merriam, Knuth nor Himmel, either alone or in combination, disclose, teach or suggest a method and apparatus notifying a user of a

message upon sensing a portable wireless device **has been moved**, as recited by claims 16 and 33.

Accordingly, for at least all the above reasons, claims 16 and 33 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 17, 34 and 35 over Merriam in view of Knuth and Narayanaswami

Claims 17, 34 and 35 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Merriam in view of Knuth, and further in view of U.S. Patent No. 6,477,177 to Narayanaswami et al. ("Narayanaswami"). The Applicants respectfully traverse the rejection.

Claims 17, 34 and 35 are dependent on claims 1 and 18 respectively, and are allowable for at least the same reasons as claims 1 and 18.

Claims 17, 34 and 35 recite an apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**.

As discussed above, neither Merriam nor Knuth, either alone or in combination, disclose, teach or suggest an apparatus notifying a user of a message upon sensing a portable wireless device **has been moved**, as recited by claims 17, 34 and 35.

The Office Action relies on Narayanaswami to allegedly make up for the deficiencies in Merriam in view of Knuth to arrive at the claimed invention. The Applicants respectfully disagree.

Narayanaswami appears to disclose a wearable mobile computing device/appliance (a wrist watch) with a high resolution display that is capable of wirelessly accessing information from a network and a variety of other devices (Narayanaswami, Abstract). A Cirrus Logic CL-EPP7211, a single-chip embedded controller, functions as a CPU for ultra-low-power applications (Narayanaswami, col. 3, lines 51-67). A motion sensor is used for power management, display control, etc. (Narayanaswami, col. 6, lines 1-23).

Although Narayanaswami discloses a motion sensor, the motion sensor is used to control power management and display control **NOT** notifying a

user of a message upon sensing a portable wireless device **has been moved**, as recited by claims 17, 34 and 35.

Accordingly, for at least all the above reasons, claims 17, 34 and 35 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

William H. Bollman
Reg. No. 36,457

MANELLI DENISON & SELTER PLLC
2000 M Street, NW 7th Floor
Washington, DC 20036-3307
TEL. (202) 261-1020
FAX. (202) 887-0336
WHB/df